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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,124	02/27/2004	Thomas E. Still	12007-0040	4684

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EXAMINER

MICHALSKI, SEAN M

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/787,124	Applicant(s) STILL, THOMAS E.	
	Examiner Sean M. Michalski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/27/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/27/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. Examiner has given the IDS submitted 6/18/2004 full consideration.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the clamping device, roughened surface or adhesive layer must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: It is unclear from the specification how the workpiece would interact with the invention. For the Examiners convenience, an explanation of the operation of the tool would be helpful.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claim 1 line 3, "and which is activatable by a handle" does not clearly associate the handle with any element. It is unclear whether applicant means for the handle to activate the cutting device (line 1), the base plate (line 1), the shaft (line 2), or the cutting wheel (line 2). Since this limitation is unclear, examination with respect to the prior art will be done as the claim is best understood by the examiner. Examiner believes applicant to mean that the handle activates the shaft.

6. Regarding claim 7 line 2, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

7. Regarding claim 13 line 2, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by

"or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

8. Regarding claim 17, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-16 rejected under 35 U.S.C. 102(b) as being anticipated by Chabbert (USPN 5,020,226).

11. Regarding claim 1, Chabbert discloses a cutting device (10 figure 1) capable of use on plastic horseshoes comprising a base plate (32 figure 2) that bears a shaft (within 44 figure 2) which carries a cutting wheel (24 figure 2) adjacent to a workpiece support (34 figure 3 is seen supporting a workpiece and being adjacent to a cutting wheel) and the shaft may be activated by a handle (22 figure 2; the handle will ratchet to drive the shaft and thereby, the cutting tool).

12. Regarding claim 2, Chabbert discloses that the base plate supports a bearing block (44 figure 7 is a bearing or bearing block; column 4 line 45).

13. Regarding claims 3 and 4, Chabbert discloses an angle (44 figure 2) that supports or bears the support of the shaft, and the angle projects upwardly from the base plate at an angle of 90 degrees (see figure 2)
14. Regarding claim 5, Chabbert discloses that the shaft is guided in a sleeve (44 is a bushing – a type of sleeve; column 4 line 50-55).
15. Regarding claim 6, Chabbert discloses that the cutting wheel (24 figure 2) is mounted to the shaft in a replaceable manner (since the wheel is held on by a nut 56 and washer 72, figure 2, it is replaceable).
16. Regarding claim 7, Chabbert discloses that the cutting wheel is a circular saw blade (see figures 4, 6 and 8—all show saw blades)
17. Regarding claim 8, Chabbert discloses that the cutting wheel has an acute conical grinding on one side (see figure 7, which shows 26 tapering from top to bottom, and being acute in angle).
18. Regarding claim 9, Chabbert discloses that the cutting wheel comprises an asymmetric toothing profile (seen most clearly in figure 8).
19. Regarding claim 10, Chabbert discloses a protective plate (36 figure 3) located above the area the cutting wheel is situated.
20. Regarding claim 11, Chabbert discloses that the sense of the shaft is reversible. In column 5 lines 3-6, Chabbert states that the ratchet mechanism used to drive the shaft may be of the reversible kind, “to permit rotating the drive in the other direction”, which is the ‘opposite sense’.

21. Regarding claim 12, Chabbert discloses that the handle is a lever (see figure 1) adapted to be extended (it may extend up or down while in operation, through the course of normal ratchet tool usage).

22. Regarding claim 13, Chabbert discloses that the handle is a hand ratchet (column 4 lines 55-66) and it is attached to the profiled end of the shaft (this is done by socket 54—a standard tool socket, which has a profile matching that of the end of the shaft; column 4 lines 65-68).

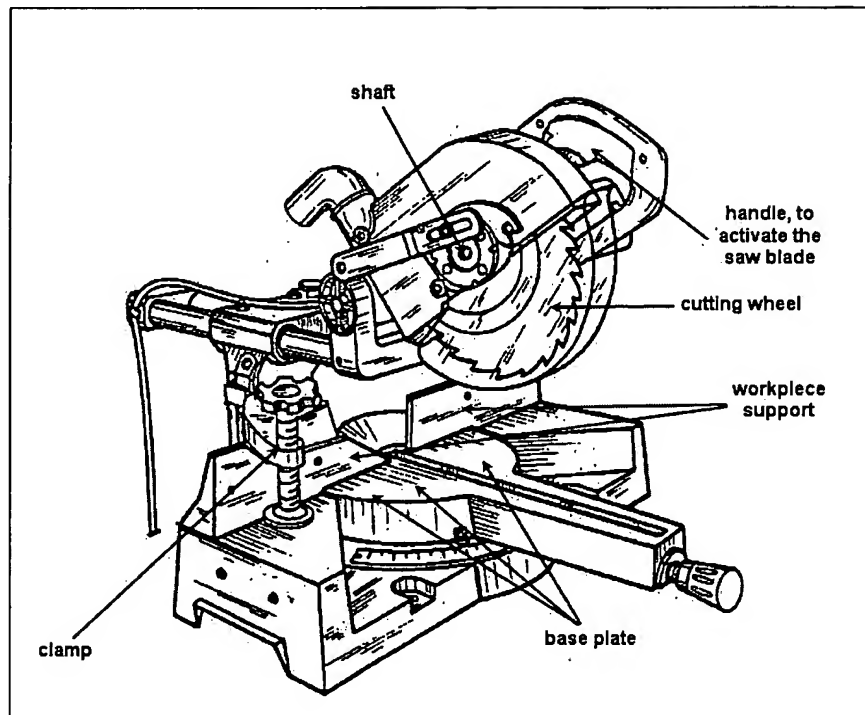
23. Regarding claim 15, Chabbert discloses that the workpiece support defines a cutting gap (between 20 and 20 figure 1, 22 figure 1) extending toward the cutting wheel (the gap extends from 20 and 20 to the cutting wheel figure 1).

24. Regarding claims 14 and 16, Chabbert discloses that the workpiece support is adaptable, and adaptable to the shape of a hoof. The workpiece support is adaptable in that it may be ground, cut, welded, abraded, or bent into other shapes. If it has been cut off, it may be reattached with glue, a weld, or other bonding agent. Since the material was made into the form shown, it may certainly be re-machined using one of the above methods or another common method. Therefore, the support is adaptable and replaceable.

25. Claims 1 and 17 are rejected under 35 U.S.C. 102(B) as being anticipated by Arehart (USPN D336,652).

26. Regarding claim 1, Arehart discloses a cutting device, capable of cutting plastic horseshoes, comprising a base plate which bears a shaft the shaft carrying a cutting

wheel adjacent to a workpiece support. The handle activates the shaft and cutting. See commented figure below.



27. Regarding claim 17, Arehart discloses that the workpiece holder has a clamp (seen above), which is a fixing means.

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

30. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arehart in view of Huang-Mo et al. (USPN 5,605,086).

Regarding claim 18, Arehart does not disclose that the workpiece support comprises a roughened, ribbed or adhesive surface.

Huang-Mo et al. teaches a roughened or ribbed surface (see ribs or roughness features 13 figure 1) on a workpiece surface (14 is a workpiece surface since the workpiece rests against it).

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Arehart by roughening the workpiece surface as taught by Huang-Mo et al. The motivation to combine is that roughening the surface will allow the workpiece to be elevated at several different angles.

Conclusion


31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawakami et al.; Graef; Lambert et al.; Sherman; Hassel et al.; Graff; Hemje.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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